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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/575,145

05/23/2000

Paul Lapstun

NPA035US

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02/22/2006

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AUSTRALIA

EXAMINER

PHAM, THIERRY L

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/575,145	Applicant(s) LAPSTUN ET AL.	
	Examiner Thierry L. Pham	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/19/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

- This action is responsive to the following communication: RCE filed on 1/23/06.
- Claims 1 and 3-18 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/23/06 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-4, 9-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori (US 6137590), and in view of Dymetman et al (US 6330976).

Regarding claim 1, Mori discloses a method of printing (printing image data, fig. 7, col. 1, lines 6-9) a digital photograph including the following steps:

- a computer system (identification code assignment mean 7 & 9, fig. 6 & 22) allocating and recording (col. 1, lines 55-67 and col. 4, lines 1-5) a photograph identification code (identification code 10a, fig. 7);
- computer system automatically (automatically assigns identification code corresponding to image data, col. 4, lines 1-5 and col. 10, lines 60-67) associating said photograph with said photograph identification code;

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- transmitting (transmitting from external source such as PC 10, fig. 16) instructions for printing the photograph to a printer (printer 1, fig. 16);
- printing (printer 1, fig. 16) the photograph onto a surface (media 10, fig. 7) using the printer;
- also printing on the surface, at the same time (col. 3, lines 46-50) as printing the photograph, coded data indicative of said photograph identification code (printing image data and identification code, fig. 7, col. 4, lines 35-38 and col. 11, lines 38-55) and of at least one reference point on the surface (identification code 10a, fig. 7, col. 4, lines 22-25), using the printer (printing section 5, fig. 6), such that an optical sensing device (optical reader 28, fig. 7), when placed in an operative position relative to the surface, can generate indicating data using at least some of the coded data (optical reader 28 for reading identification code 10a, fig. 7, notes: different types of optical reader can be used, col. 5, lines 3-45), indicating data comprising data the photograph identification code (photograph identification code 10a, fig. 7, col. 7, lines 1-5) whereby a computer system can determine a photograph identity and/or action relating to the photograph using at least some of the indicating data (correlating/corresponding image data with identification code, col. 1, lines 55-67 and col. 10, lines 62-67).

However, Mori teaches a optical reader for reading coded data in regards to identification code, but fails to teach and/or suggest indicating data regarding a position of the sensing device relative to the surface.

Dymetma, in the same field of endeavor for retrieving image data via using coded data, teaches an optical sensing device (optical reader 502, fig. 1) for reading and generating data regarding a position of the sensing device (col. 3, lines 50-67 and col. 9, lines 15-21) relative to the surface.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify optical reader of Mori to read indicating data regarding a position of the sensing device relative to the surface as taught by Dymetman because of a following reason: (•) adding more features to the optical reader, for example, the optical reader not only reads embedded coded data, but also determines the exact

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location/position of its pointer; by doing so, it ensures the users that the right coded data is read.

Therefore, it would have been obvious to combine Mori with Dymetman to obtain the invention as specified in claim 1.

Regarding claim 2, Mori further discloses a method according to claim 1 wherein the identify of the photograph is determined by an identification code (identification code 10a, fig. 7) issued by a server (external device 10, fig. 12) which issues photograph identification codes.

Regarding claim 3, Dymetman further discloses a method according to claim 1 wherein a copy of the photograph may be requested by directing an optical sensing device (pointer 502, fig. 1) towards a zone (zone within document on the surface, col. 11, lines 28-42) on the surface, which causes the optical sensing device to sense coded data on the surface and transmit a message to a printer which in turns causes the printer to print a copy of the photograph.

Regarding claim 4, Dymetman further discloses a method according to claim 1 wherein a digital copy of the photograph (i.e. digital photograph is retrieved from a server via using coded data printed on surface of the document, col. 10, lines 15-47 and col. 12, lines 58-67 and col. 18, lines 45-56) is archived separately from the printed photograph and the original digital photograph. Also see Mori's reference for more details regarding retrieving image data using identification code (cols. 10, lines 60+).

Regarding claim 9, Mori further discloses a method according to claim 1 wherein data indicative of an action is forwarded from an optical sensing device (optical reader 28, fig. 7) to a printer (printer 14, fig. 7) when the optical sensing device is used to designate a particular zone of the surface (where identification code 10a is printed, fig. 7).

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Regarding claim 10, Dymetman further discloses a method according to claim 1 wherein the surface has printed on it one or more options which a user may select, each associated with a designated zone on the surface, and the user selects an option by moving an optical sensing device on the surface within the associated zone (using zones, col. 16, lines 52-61), the optical sensing device transmitting data indicative of the user's selection to a printer.

Regarding claim 11, Dymetman further discloses a method according to claim 1 wherein a user annotates the photograph with text by writing with an optical sensing device on the surface, data indicative of the movement of the optical sensing device being transmitted to a printer and converted to computer text (pointer device 502 for writing text on coded substrate, col. 17, lines 5-36).

Regarding claim 12, Dymetman further discloses a method according to claim 1 wherein a user signs the photograph by writing the user's signature on the surface with an optical sensing device (pointer device 504, col. 17, lines 10-35), data indicative of the movements of the optical sensing device being transmitted to printer, the signature thereafter being verified by comparison with a known signature of the user (signature authentication and handwriting recognition, col. 17, lines 5-35 and col. 22, lines 61-65).

Regarding claim 13, Dymetman further discloses a method according to claim 1 wherein a user requests one or more other documents or photographs to be printed (i.e. Fax icon, col. 22, lines 24-48) by directing an optic sensing device to a zone on the surface (zones, col. 16, lines 51-62).

Regarding claim 14, Dymetman further discloses a method according to claim 1 wherein a user requests one or more other documents or photographs to be printed by directing an optional sensing device to a zone on the surface (pointer 502 for sensing and retrieving documents to be printed via using coded data, col. 8, lines 45-67 and col. 9, lines 10-45).

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Regarding claims 15-17, Dymetman teaches where the coded data is printed using an infrared ink and/or infrared-absorptive ink (cols. 11, lines 45-67 to col. 12, lines 1-25).

Regarding claim 18, the printer automatically binds the pages together are widely known in the art (i.e. copy machine with stapler options).

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori and Dymetman as described in claim 1 above, and in view of McIntyre et al (U.S. 6102505).

Regarding claim 5, Mori and Dymetman teaches limitations (b) through (e) (see claim 1 above for more details), but does not teach a photograph is taking using a digital camera.

McIntyre, in the same field of endeavor for coded data, teaches a digital camera for taking digital photograph images (digital camera, fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Mori and Dymetman as per teachings of McIntyre because of a following reason: (●) a digital camera which allows operator to take digital images and encrypted with barcodes.

Therefore, it would have been obvious to combine Dymetman and Mori with McIntyre to obtain the invention as specified in claim 5.

Regarding claims 6-7, the combinations of Mori, Dymetman and McIntyre further teaches wherein the digital camera and printer form an integrated unit (fig. 1, col. 2, lines 55-67, McIntyre), the step of transmitting the digital photograph is done by means of a transmitter located in or proximate the integrated unit, the step of assigning an identification code is conducted on a computer (barcode is assign via file server and/or printer server, col. 6, lines 26-45) remote from the integrated unit, and the identification code is transmitted from the remote computer to the integrated unit before the digital photograph is printed .

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Regarding claim 8, the photograph identification code is also sent to a digital camera which took the photograph for future reference (image took by camera is also encrypted with barcodes, cols. 4, lines 50-67, McIntyre).

Response to Arguments

Applicant's arguments, see pages 5-6, filed 11/28/05, with respect to the rejection(s) of claim(s) 1 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of different interpretations of previous applied art references.

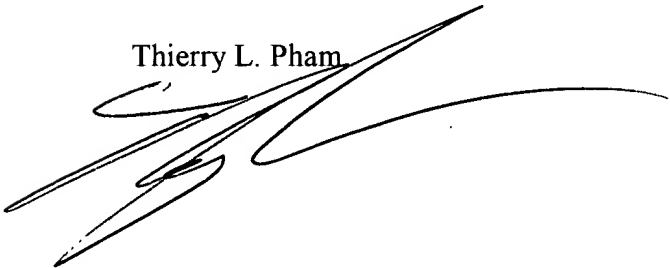
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA
PRIMARY EXAMINER

